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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,596	06/15/2000	Scott E. Andersen	38-21(15878)B	7446

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EXAMINER

ARTHUR, LISA BENNETT

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 01/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/594,596

Applicant(s)

ANDERSEN ET AL.

Examiner

Lisa B. Arthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 25 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-9 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. This action is in response to the papers filed October 25, 2001. Currently, claims 1-9 are pending. The action includes an examination of Group 1.

2. Applicant's election with traverse of Group 1, SEQ ID NO 1 of claim 1, in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the examination of all of SEQ ID NO 1-10,953 would not be a serious burden because all of these sequences are related nucleic acids. This is not found persuasive because search over 10,000 different sequences is fact a huge burden. The argument that the sequences are related is persuasive because the sequences are related only in the source from which they were obtained. Each of the 10,953 sequences of the claims has a unique structure such that they are unobvious over one another.

The requirement is still deemed proper and is therefore made FINAL.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility. The claimed nucleic acid is not supported by a specific asserted utility because the specification only states that the cDNA compound is useful as a probe for obtaining the full length coding sequence or the gene, which would be used to make protein. Once the protein was obtained, the protein would be used in conducting research to functionally characterize the protein. However, a starting material which can only be

used to produce a final product of unknown function does not have a specific asserted utility when that final product does not have a specific utility. In this case the protein that would be produced as a final product resulting from processes involving SEQ ID NO 1 has no asserted or otherwise identified specific utility. The research contemplated by Applicant to establish utility for a potential protein product by elucidating its properties and function of the protein has not been specified and does not constitute a specific utility. The specification does not describe any other specific use for SEQ ID NO 1. Also, because the claimed invention is not supported by a specific asserted utility for the reasons given above, credibility can not be assessed. Neither the specification nor any art of record discloses or suggests an activity for SEQ ID NO 1 such that another non-asserted utility would be well-established.

4. Claim 1 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

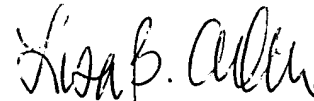
The claims are drawn to a nucleic acid encoding a wheat protein or a fragment thereof comprising SEQ ID NO 1. However, the specification only describes a nucleic acid which is an EST and which has the sequence of SEQ ID NO 1. SEQ ID NO 1 appears to be a fragment of a larger protein since it was isolated from a cDNA library. However, the specification has provided no teachings as to a function for a protein encoded by isolated SEQ ID NO 1 and provides no description of the remainder of the coding sequence of which SEQ ID NO 1 is a fragment. The structure of the full-length coding sequence is completely unknown from the specification. There is no description of what type of protein SEQ ID NO 1 might be encoding. Consequently, the specification does not support applicant's possession of a nucleic acid encoding a wheat protein at the time of filing.

6. No claims are allowable. While the prior art teaches nucleic acids comprising a sequence very similar to SEQ ID NO 1, it does teach a nucleic acid containing the exact sequence of SEQ ID no 1. See attached sequence alignment.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa B. Arthur whose telephone number is (703) 308-3988. The examiner can normally be reached on Monday-Wednesday from 7:00 am to 2:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for the organization where this application or proceeding is assigned is 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.



LISA B. ARTHUR  
PRIMARY EXAMINER  
GROUP 1800

January 8, 2002